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In re Application of LEE et al.
Application No.: 10/565,313
PCT No.: PCT/SG04/00215
Int. Filing: 16 July 2004
Priority Date: 18 July 2003
Attorney Docket No.: DR10/012
For: MESSAGE SYSTEM

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 08 December 2006, to accept the application without the signatures of joint inventors, KING HOE GOH and FRANCIS YEW HONG LEE.

BACKGROUND

On 18 January 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 09 June 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) was required.

On 08 December 2006, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signatures of inventors alleging that Mr Goh and Mr. Lee are unavailable to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known addresses of non-signing inventors were provided. With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventors was submitted and satisfies the requirements of 37 CFR 1.47(a).

With respect to Item (2) above, Petitioner provided the affidavit of the joint inventors in support of the petition under 37 CFR 1.47(a). The inventors merely state that they "have been informed by StarHub... that a diligent effort has been made on our behalf by StarHub to contact

the co-inventors Goh King Hoe by registered post at his last known address....[and that] An inventor's declaration was also sent to Mr. Francis Yew Hong Lee by registered post at his last known address..However, StarHub Ltd was unable to obtain the necessary signatures of Mr. Goh and Mr. Lee.". This is not a statement of first hand knowledge nor does it detail the efforts made to locate the nonsigning inventors or their refusal to sign the application papers. The statement is accompanied by a copy of a letter sent to the non-signing inventors, indicating that only a declaration and assignment document were enclosed.

Refusal to Sign the Application

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or , if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956)

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

Here, Petitioner did not present a complete copy of the application papers including specification, claims and drawings and oath or declaration to the non-signing inventors for their

signatures. Where the non-signing inventors' conduct constitutes a refusal, a statement of facts based upon first hand knowledge in support of the petition should be submitted.

Inability to Locate or Reach Non-signing Inventors

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the instant petition, Petitioner did not demonstrate what "diligent efforts" were undertaken to locate the nonsigning inventors to obtain their signatures on the declaration. No further efforts to locate the nonsigning inventors were attempted and detailed in a first hand statement of facts. A statement by the person with first hand knowledge, which fully describes the exact facts relied on to establish that a diligent effort was made, is required. The diligent efforts to locate the nonsigning inventors were not pursued and documented such as Internet searches, contact with the joint inventors to obtain the nonsigning inventors' current address, current email address and/or current employer. No attempt to reach the nonsigning inventors by telephone was made. No request from the Postal Service for their forwarding address was made.

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for the nonsigning inventors' new address was made. Since no attempts to locate the inventors were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventors.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventors. Under these circumstances, it cannot be concluded that the nonsigning inventors are unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/565,313 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signature and their refusal to sign these documents and (2) that "a diligent effort" was made to contact or locate the nonsigning inventors. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

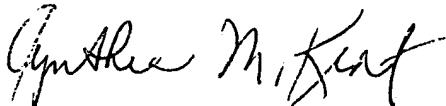
For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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